

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of:

Attorney Docket No.: 1915.14US03

Kasner, et al.

Confirmation No.: 9685

Application No.: 09/862,905

Examiner: Michael Safavi

Filed: May 22, 2001

Group Art Unit: 3637

For: RIDGE CAP TYPE ROOF VENTILATOR

APPELLANT'S REPLY BRIEF UNDER 37 CFR § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer of January 24, 2009, Appellant makes the following reply:

I. STATUS OF CLAIMS

Originally issued claims 1-15 were canceled in a preliminary amendment filed concurrently with this application.

Claims 18-20, 35-48, 50, 53, 55, 57, and 61-70 were canceled during prosecution of this application.

Claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 were rejected under 35 U.S.C. § 251 in the Office Actions of June 12, 2008, November 14, 2007, December 11, 2006, and December 19, 2005. The rejection of claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 is being appealed.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 were properly rejected under 35 U.S.C. § 251 for a defective reissue declaration.

III ARGUMENT

The Examiner, in the Examiner's Answer, reiterates the rejection of claims under 35 U.S.C. § 251, restating his reliance on MPEP 1414(II)(C), which reads:

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. A statement of 'failure to include a claim directed to . . .' and then presenting a newly added claim, would not be considered a sufficient 'error' statement since applicant has not pointed out what the other claims lacked that the newly added claim has.

Examiner's Answer, pp. 4-6. It is important to note, however, that this statement in the MPEP is not supported by law and attempts to impose a requirement in excess of what the law actually now requires for an error statement in a reissue declaration.

The United States Court of Appeals for the Federal Circuit has recently re-emphasized that correction of claiming errors through reissue is not limited to specific errors in claim language. Medrad, Inc. v. Tyco Healthcare Group LP, 466 F.3d 1047, 1052 (Fed. Cir. 2007). Rather, 35 U.S.C. § 251 is properly read to allow correction of any error that causes a patentee to claim more or less than he had a right to claim, whether that error can be traced to any particular claim language in the original patent claims or not. Id. This Board has even more recently recognized implicitly that the passages of MPEP 1414(II) stating and implying that a reissue error statement must identify specific claim language are incorrect. See Ex Parte Smith, 2008 WL 4190003, *4 (Bd. Pat. App. & Interf. September 11, 2008).

Indeed, In re Constant, the only authority cited in MPEP 1414(II) for support of the Office's error statement requirements, is no longer good law. See In re Constant, 827 F.2d 728 (Fed. Cir. 1987). At the time of the In re Constant decision, Rule 175(a) read as follows:

- (a) Applicants for reissue, in addition to complying with the requirements of § 1.63, must also file with their applications a statement under oath or declaration as follows:
 - (1) When the applicant verily believes the original patent to be wholly or partly inoperative or invalid, stating such belief and the reasons why.
 - (2) When it is claimed that such patent is so inoperative or invalid ‘by reason of a defective specification or drawing,’ particularly specifying such defects.
 - (3) When it is claimed that such patent is inoperative or invalid ‘by reason of the patentee claiming more or less than he had the right to claim in the patent,’ **distinctly specifying the excess or insufficiency of the claims.**

37 C.F.R. § 1.175(a) (1985) [emphasis added]. The court in In re Constant, interpreting this version of Rule 175, held that it required specific identification of all errors in the claims. In re Constant, 827 F.2d at 729.

Rule 175, however, was extensively revised to its current form after the In re Constant decision. See 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997. The language of 37 C.F.R. § 1.175(a)(3) that was the basis for the Court’s holding, was eliminated. Rule 175(a) now reads simply:

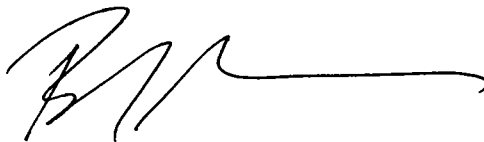
- (a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:
 - (1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and
 - (2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

37 C.F.R. § 1.175(a)(2009). There is no longer any requirement in this current version of Rule 175(a) for errors in claim language to be explicitly identified in the error statement. Since the

language upon which the In re Constant decision was predicated has been completely abrogated, In re Constant is no longer good law, and cannot be relied upon by the Office.

In short, the requirements of MPEP 1414(II), which are the only legal basis relied upon by the Office for rejecting Applicant's reissue declaration as lacking a proper error statement, are not supported by the law. The Federal Circuit and this Board have previously stated that specific identification of erroneous original claim language is not required in for a reissue declaration error statement to support reissue. Consequently, the rejection of claims 16-17, 21-34, 49, 51-52, 54, 56, and 58-60 must be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'B. J. Thorson', with a long horizontal flourish extending to the right.

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